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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86406889
Applicant	America Directo Corporation
Applied for Mark	SMARTSOCKS
Correspondence Address	MATTHEW H. SWYERS, ESQ. THE TRADEMARK COMPANY, PLLC 344 MAPLE AVE W STE 151 VIENNA, VA 22180-5612 UNITED STATES mswyers@thetrademarkcompany.com
Submission	Appeal Brief
Attachments	Brief of the Applicant.pdf(288268 bytes)
Filer's Name	Matthew H. Swyers
Filer's e-mail	mswyers@TheTrademarkCompany.com
Signature	/Matthew H. Swyers/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of America Directo Corporation

Serial No. 86406889

Trademark: SMARTSOCKS

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BRIEF OF THE APPLICANT

TABLE OF CONTENTS

	Page No.s
Table of Authorities.....	3
I. Introduction.....	5
II. Statement of the Case.....	5
III. Argument.....	6
<i>A. Cited Registrations Owned by Diverse Owners.....</i>	8
<i>B. Overlapping Terms Descriptive.....</i>	9
<i>C. The Trademarks Are Dissimilar.....</i>	12
IV. Conclusion.....	13

TABLE OF AUTHORITIES

CASES:

<i>Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank</i> , 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).....	7
<i>First Savings Bank F.S.B. v. First Bank System Inc.</i> , 101 F.3d at 645, 40 USPQ2d 1865, 1870 (10 th Cir. 1996).....	6, 7
<i>General Mills, Inc. v. Kellogg Co.</i> , 824 F.2d 622, 3 USPQ2d 1442 (8th Cir. 1987).....	7
<i>Hewlett-Packard Co. v. Packard Press Inc.</i> , 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).....	7
<i>In re Decombe</i> , 9 USPQ2d 1812 (TTAB 1988).....	8
<i>In re Dixie Restaurants Inc.</i> , 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).....	6
<i>In re E.I. du Pont DeNemours & Co.</i> , 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).....	6
<i>In re Pellerin Milnor Corp.</i> , 221 USPQ 558 (TTAB 1983).....	8
<i>In re Shell Oil Co.</i> , 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).....	7
<i>J & J Snack Foods Corp. v. McDonald's Corp.</i> , 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).....	7
<i>Local Trademarks, Inc. v. Handy Boys Inc.</i> , 16 USPQ2d 1156 (TTAB 1990).....	8
<i>Luigino's Inc. v. Stouffer Corp.</i> , 50 USPQ2d 1047.....	7
<i>Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.</i> , 875 F.2d 1026, 10 USPQ2d 1961 (2d Cir. 1989).....	6
<i>Octocom Systems Inc. v. Houston Computer Services Inc.</i> , 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).....	7
<i>Paula Payne Products Co. v. Johnson Publishing Co.</i> , 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973).....	7
<i>Quartz Radiation Corp. v. Comm/Scope Co.</i> , 1 USPQ2d 1668 (TTAB 1986).....	8

<i>Shen Manufacturing Co. v. Ritz Hotel Ltd.</i> , 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004).....	7
-----------------------------------------------------------------------------------------------------------	---

<i>Universal Money Centers, Inc. v. American Tel. & Tel. Co.</i> , 22 F.3d 1527, 30 USPQ2d 1930 (10th Cir. 1994).....	6
------------------------------------------------------------------------------------------------------------------------------	---

OTHER AUTHORITIES:

TMEP § 1207.01(a)(i).....	8
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TMEP § 1207.01(a)(iii).....	7
-----------------------------	---

TMEP § 1207.01(d)(vii).....	8
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I. INTRODUCTION

COMES NOW the Applicant America Directo Corporation (hereinafter “Applicant”) and through counsel The Trademark Company, PLLC, and provides this Brief of the Applicant in support of its appeal of the examining attorney’s refusal to register the instant mark.

II. STATEMENT OF THE CASE

On or about September 26, 2014 Applicant filed the instant trademark with the U.S. Patent and Trademark Office seeking to register the same on in connection with the following goods: Hosiery; Socks.

On or about January 20, 2015 the Examining Attorney refused registration of the Applicant’s trademark on the grounds that, if registered, it would create a likelihood of confusion

with the registered trademark  and  more fully set forth in U.S. Registration No. 4649441 and 2734333, respectively. Of note, both cited registrations disclaimed the terms SMART and SOCKS apart from the registrations cited against Applicant’s trademark.

On or about May 13, 2015 Applicant filed a response to the Office Action dated January 20, 2015 arguing in support of registration. However, ultimately Applicant’s argument was not deemed persuasive by the Examining Attorney and, accordingly, on or about June 9, 2015 the Examining Attorney made the refusal final.

The instant appeal now timely follows.

III. ARGUMENT

The Standard for a Determination of a Likelihood of Confusion

A determination of likelihood of confusion between marks is made on a case- specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed . Cir. 1997). The Examining Attorney is to apply each of the applicable factors set out in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are:

- (1) The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing;
- (5) The number and nature of similar marks in use on similar services; and
- (6) The absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

Id.

The Examining Attorney is tasked with evaluating the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the Examining Attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel.*

Co., 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are confusingly similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10th Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark “Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods with which the marks are used, the nature and scope of a party’s goods must be determined on the basis of the goods recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston ComputergoodsInc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). *See generally* TMEP § 1207.01(a)(iii).

Even if the marks are similar, confusion is not likely to occur if the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create an incorrect assumption that they originate from the same source. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir.

2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Purchasers who are sophisticated or knowledgeable in a particular field are not necessarily immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is clear that confusion is not likely as between Applicant's trademark and the trademark cited and, accordingly, the refusal to register SMARTSOCKS should be withdrawn.

A. Cited Registrations Owned by Diverse Owners

Initially, it is noted that the cited registrations are owned by diverse registrants. During the examination of an application, the examining attorney should consider separately each registration found in a search of the marks registered in the USPTO that may bar registration of the applicant's mark under §2(d). If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion. TMEP §1207.01(d)(x).

Generally, registration of more than one trademark by diverse entities indicates dilution of the cited terms as it applies to the applied-for trademark. §1207.01(d)(x) As such, it is respectfully submitted that dilution of the terms involved in the instant refusal are sufficient enough that fact favors a finding of an absence of a likelihood of confusion under the relevant *du Pont* factors.


B. Overlapping Terms Descriptive

Moreover, if the common element of two marks is “weak” in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB’s holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER’S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women’s shoes, not likely to cause confusion); *In re Istituto Sieroterapico E Vaccinogeno, Toscano “SCLAVO” S.p.A.*, 226 USPQ 1035 (TTAB 1985) (holding ASO QUANTUM (stylized, with “ASO” disclaimed) for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion).

See also Safer, Inc. v. OMS Invs., Inc., 94 USPQ2d 1031, 1044-45 (TTAB 2010) (holding DEER-B-GON for animal repellant used to repel deer, other ruminant animals, and rabbits, and DEER AWAY and DEER AWAY PROFESSIONAL for repellant for repelling deer, other big

game, and rabbits, not likely to cause confusion, noting that “DEER” is descriptive as applied to the relevant goods and thus has no source-indicating significance); *Bass Pro Trademarks, L.L.C. v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner’s and respondent’s marks were similar by virtue of the shared descriptive wording “SPORTSMAN’S WAREHOUSE,” this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH’S GOLD’N CRUST and design (with “GOLD’N CRUST” disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because “GOLDEN CRUST” and “GOLD’N CRUST” are highly suggestive as applied to the respective goods, the addition of “ADOLPH’S” is sufficient to distinguish the marks); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB’s holding that contemporaneous use of applicant’s CAPITAL CITY BANK marks for banking and financial services, and opposer’s CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase “City Bank” is frequently used in the banking industry and that “CAPITAL” is the dominant element of applicant’s marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer’s marks); *In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55-56 (TTAB 1984) (holding DESIGNERS/FABRIC (stylized) for retail fabric store services, and DAN RIVER DESIGNER FABRICS and design for textile fabrics, not likely to cause confusion, noting that, because of the descriptive nature of “DESIGNERS/FABRIC” and “DESIGNER FABRICS,” the addition of “DAN RIVER” is sufficient to avoid a likelihood of confusion).

In the instant case, the trademarks at issue share the same, weak, overlapping term(s),

namely SMART and SOCKS. Specifically, the cited trademark , U.S. Reg. No. 4649441, includes a disclaimer for “SMARTSOCKS” specifically conceding “No claim is made to the exclusive right to use “smartsocks” apart from the mark as shown”. See Response to Office Action dated December 7, 2011, U.S. Reg. No. 4649441.

Moreover, the cited trademark , U.S. Reg. No. 2734333, also contains a disclaimer for the terms “SMART SOCKS”. See U.S. Reg. No. 2734333.

As the case law sets forth above, if the primary similarity as between the Applicant’s Trademark and that of the registrant are descriptive in nature, this consideration must also lend to a conclusion of an absence of a likelihood of confusion under *du Pont*.

Applying the law and the facts of the instant cited registrations to the case at hand, both registrations disclaimed “SMARTSOCKS” or “SMART SOCKS” as being descriptive with reference to socks. Applicant has applied to register the term SMARTSOCKS with reference to socks. As such, it is submitted that the Office has established that the terms at issue are merely descriptive for socks and, as such, the fact that one or more registrants may have trademarks which include disclaimed descriptive terms the same should not bar a third applicant from registering a like mark merely on account of terms the registrants have respectfully conceded they do not retain exclusive rights in the same.

Accordingly, for this reason as well it is submitted that the refusal under Section 2(d) of the Act be reversed and the instant Application permitted to register.

C. The Trademarks Are Dissimilar

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973)). Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related. Rather, taking into account all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar, but a similarity of one factor is not dispositive of the entire analysis. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

Additions or deletions to marks are often sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

Finally, it is submitted that the trademarks are simply not sufficiently alike, especially in consideration of the descriptiveness of the overlapping term at issue, to permit a continued refusal of the instant mark. Applicant applied to register the standard character term SMARTSOCKS in connection with socks. The cited registrations, which were permitted to register over one another, were highly stylized trademarks set forth as follows:



Although arguably the three trademarks share the same descriptive terms, the dominant portions of the cited registrations are HEEL 2 HEAL and the logo design encircling the words therein. As such, and again in consideration of the disclaimers inserted by both registrants which recognize that the dominant portions of their trademarks is not SMART SOCKS or the equivalent, it is submitted that the marks, despite the similarities in other *du Pont* factors, are simply not similar enough to justify the continued refusal under Section 2(d) of the instant trademark given the record before this honorable tribunal.

Accordingly, and again, it is respectfully requested that the Trademark Trial and Appeal Board reverse the decision of the Examining Attorney.

IV. CONCLUSION

Based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's Trademark.

WHEREFORE it is respectfully requested that the Trademark Trial and Appeal Board reverse the decision of the Examining Attorney, remove as an impediment the cited trademarks, and approve the instant Application for publication.

Respectfully submitted this 8th day of February, 2016,

THE TRADEMARK COMPANY, PLLC

/Matthew H. Swyers/
344 Maple Avenue West, PMB 151
Vienna, VA 22180
Tel. (800) 906-8626 x100
Facsimile (270) 477-4574
mswyers@thetrademarkcompany.com